

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Robert C. Ladner <i>et al.</i>	Art Unit :	1639
Serial No. :	10/656,350	Examiner :	Jeffrey S. Lundgren
Filed :	September 5, 2003	Conf. No. :	8718
Title :	DISPLAY LIBRARY PROCESS		

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed June 15, 2006, Applicants elect the invention of Group I, inclusive of claims 1-18 and 20-28. The election is made with traverse.

Applicants believe that the claims of Groups I (claims 1-8 and 20-28) and II (claim 19) do not require different fields of search and that the restriction among these groups is improper. Applicants therefore respectfully request that the Examiner withdraw the restriction between Groups I and II and examine claims 1-28 together in the present application.

According to MPEP § 803, for a requirement for restriction to be proper: (1) “[t]he inventions must be independent or distinct as claimed; and [2] [t]here would be a serious burden on the examiner if restriction is not required” (citations omitted). Both of these criteria must be met in order for a restriction to be applied.

Here, there is no undue burden. The method of claim 1 (in Group I) and the method of claim 19 (in Group II) have many of the same steps. Claim 19 differs, for example, in that it refers to “a first and a second target.” Applicants are at a loss as to how the use of a second target would alter the field of search and place an additional burden on the Examiner. Elaboration is requested.

It appears that the Office has applied a general policy of restricting independent claims into separate groups. Such policy, however, should be tempered by an inquiry into whether there is an actual burden on the Examiner. The Examiner states that “the inventions [of Groups I and II] require a different field of search (see MPEP § 808.02), and have divergent subject matter that results in a substantial burden for the search and examination of more than a single invention” (Office Action at page 2). Applicants request that the Office indicate how claim 19

has “divergent subject matter” from claim 1. While the scopes of the two claims differ, they do not “diverge” to a degree that would cause a substantial burden for the search and examination. Applicants also respectfully request that the Office specify what search terms would be use for Group II that would not be used for Group I, and conversely what search terms would be used for Group I, but would not be used for Group II.

No statement herein is an admission that any claim is not patentably distinct from another or that any claim is obvious over another.

No fees are believed to be due. Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney's Docket Number 10280-053001.

Respectfully submitted,

Date: July 17, 2006

/Anna Solowiej/
Anna Solowiej, Ph.D.
Reg. No. 57,093

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906